

REMARKS

The present Amendment and Response is submitted in reply to the final Office Action dated March 20, 2008 ("the Office Action"). In the Office Action, claims 1-46 stand rejected. By this Amendment, Claims 1, 21, 22, 38 are amended, no claims are added, and claims 3 and 24 are canceled, such that claims 1, 2, 4-23, and 25-46 are pending in the application. No new matter is presented.

Claim Rejections Under § 103

Claims 1-46 stand rejected under 35 U.S.C. §103(a) as unpatentable over applicant admitted prior art and U.S. Patent No. 7,168,221 ("Hunter") as referenced by U.S. Patent No. 5,927,032 ("Record") or U.S. Patent No. 7,100,342 ("Holloway" or "the '342 Patent") or U.S. Patent No. 4,125,984 ("Jonas").

Claim 1 as amended relates, in part, to delivering a foam material into at least a portion of a space between the perimeter of the frame of a fenestration unit and the perimeter of the rough opening of a composite wall panel.

Applicants submit that Record, Holloway, and Jonas teach away from the proposed combination. Teaching away from the claimed invention is the antithesis of the art's suggesting that the person of ordinary skill go in the claimed direction. Essentially, teaching away from the art is a *per se* demonstration of lack of *prima facie* obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988).

Record, Holloway, and Jonas, specifically describe connecting building panels using rigid framing and attaching the building panels together using mechanical fasteners attached to the framing, rather than at least a panel core as recited in claim 1. For example, Record describes magnesium oxide outer bracing 16, 18, 20, 22 (col. 5, lines 39-43) and the use of tongues/splines to secure panels together with the bracing (col. 5, ll. 58-62). Holloway describes an outer framework of I-beams used to accommodate posts for linking adjacent panels (abstract). Jonas describes metal extruded frame members that form a protective edge around panels and mechanical connects that mate with the metal frame members (col. 2, lines 10-41). Thus, the cited references instead teach away from the limitations of claim 1 by

describing the use of framing plus mechanical fasteners and not direct connection to a panel core, much less the use of foam materials for adhering a fenestration unit to at least an insulating core of a composite wall panel.

It is well settled that a combination which abandons or destroys the intended functionality of the primary reference fails to establish a *prima facie* case of obviousness. One of ordinary skill in the art would not be motivated to make a modification that radically alters the design of the primary reference in the absence of express or implicit teaching. In short, there would be no apparent reason for engaging in the modification or change. To the contrary, there would be a disincentive. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). Record, Holloway, or Jonas rely on robust mechanical mechanisms to attach their building panels. Applicants submit that the proposed combination with Hunter is not proper because the intended function of the attaching structures in Record, Holloway and Jonas would be destroyed.

If the proposed combination changes the principle of operation of the prior art reference, then the reference is not sufficient to render the claims *prima facie* obvious. M.P.E.P. 2143.01. *In re Ratti*, 270 F.2d 810 (CCPA 1959). Applicants further submit that the proposed combination would change the operating principle of Record, Holloway and Jonas by substituting a foam adhesive for the disclosed mechanical attaching structures.

The Applicants' background is also reflective of this teaching away in the prior art. In particular, the Background indicates that an intermediate frame materials (a wood frame) and mechanical fasteners (nails) were being used to couple fenestration units to wall panels – once again describing the use of framing plus mechanical fasteners and not direct connection to a panel core, much less the use of foam materials for adhering a fenestration unit to at least an insulating core of a composite wall panel.

The Office Action turns to Hunter, a reference that relates to roof coverings rather than building panels, to provide the features of claim 1 relating to fixation to at least an insulating core of a composite wall panel and a foam material for adhering the fenestration unit to at least the insulating core. As previously referenced, Hunter specifically describes a low rise foam polyurethane adhesive 17 that is coated over a roof surface; contacts and

adheres to the entire back surface of polyurethane foam panels 10 on top of the roof surface; and then seeps through the cracks between adjacent panels 10. *Hunter* at col. 4, lines 27-44.

The application of Hunter is too disparate from securing fenestration units to a core of a composite wall panel according to the limitations of claim 1 to overcome the teaching away of the other references. Furthermore, Hunter describes applying foam polyurethane adhesive 17 across the entire back surfaces of adjacent roof panels 5. *See, e.g., Hunter* at col. 4, lines 27-36 and FIG. 4. Coating an entire back surface of a roofing panel with foam adhesive and allowing it to seep up between the panels would not lead one of ordinary skill to the limitations of claim 1. Instead, such methodology teaches away from the limitations of claim 1.

In particular, claim 1 recites that the foam material in the space between the perimeter of the frame of the fenestration unit and the perimeter of the rough opening provides at least 50% of an attachment force that resists separation of the fenestration unit from the composite wall panel along a direction generally perpendicular to a major surface of the composite wall panel. Hunter, instead, clearly forwards coating the entire underside of a roofing panel to secure it in a direction perpendicular to the roof surface. Coating the entire back side of roofing panels actually teaches away from a foam material between a fenestration unit and insulating core of a composite wall panel that provides at least 50% of an attachment force that resists separation of the fenestration unit from the composite wall panel along a direction generally perpendicular to a major surface of the composite wall panel.

Regarding method claims 1-2 and 4-21, only if a prior art device in its normal and usual operation performs the claimed method will a method claim be considered to have been anticipated by a prior art device. That is, a prior art device anticipates a later process if the device carries out the process in its normal and usual operation. *In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986); *Catalina Marketing International, Inc. v. Cool Savings.com, Inc.*, 289 F.3d 801, 809 (Fed. Cir. 2002); *Perricone v. Medicis Pharmaceutical Corp.*, 77 USPQ2d 1321 (Fed. Cir. 2005).

As discussed above, Hunter describes a low rise foam polyurethane adhesive 17 that is coated over a roof surface; contacts and adheres to the entire back surface of polyurethane foam panels 10 on top of the roof surface; and then seeps through the cracks between

adjacent panels 10. *Hunter* at col. 4, lines 27-44. Hunter does not disclose any structure that would correspond to a fenestration unit installed in a wall panel "in normal and usual operation."

For at least such reasons, claim 1 as amended is believed allowable. Independent claims 21, 22, and claim 38 are also believed allowable for reasons similar to those described in association with claim 1. Additionally, the remaining claims depend, in some form, from independent claims 1, 21, 22, or 38 and, for at least such reason, are also believed patentable.

In sum, the grounds for rejection have been addressed and withdrawal of the rejections, allowance of the claims, and notice to that effect are respectfully requested. The Examiner is invited to contact the undersigned at the number below to expedite prosecution of this application.

Respectfully submitted,

FAEGRE & BENSON LLP

By: /Victor P. Jonas, Reg. No. 58,590/
Victor P. Jonas, Reg. No. 58,590
612/766-7611
Customer No.: 25764

Dated: May 20, 2008